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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/251,641 02/17/99 REDLINE

R 297-056

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EXAMINER

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ART UNIT

PAPER NUMBER

1741

DATE MAILED:

08/22/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | | |
|------------------------------|-------------------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/251,641 | REDLINE ET AL. | |
| | Examiner Wesley A. Nicolas | Art Unit 1741 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 and 17-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 17-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
 1. received.
 2. received in Application No. (Series Code / Serial Number) _____.
 3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- | | |
|--|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 | 20) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is in response to the Amendment dated June 5, 2000. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, and 17-20 are currently pending in the case.

Election/Restrictions

1. The cancellation of non-elected claims 9-16 by Applicant has been noted.

Specification

2. The objections to the specification as set forth in the previous Office action have been withdrawn in view of the argument and amendment made by Applicant on June 5, 2000.

Information Disclosure Statement

3. The information disclosure statement submitted on June 5, 2000 was filed after the mailing date of the First Office Action on March 23, 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the petition is granted and the information disclosure statement is being considered by the examiner.

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Claim Rejections - 35 USC § 103

4. Claims 1-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrier et al. (EP 0 797 380 A1), and further in view of Wakita (5,567,357).

The rejection of claims 1-8 and 17-20 with respect to Ferrier et al. and Wakita has been **maintained** and is as set forth in the previous Office action which is incorporated herein.

REMARKS - Response to Arguments

5. Applicant's arguments filed June 5, 2000 have been fully considered but they are not persuasive.

Turning to Applicant's response of the prior art rejections, Applicant asserts that there is no motivation to combine the references of Wakita and Ferrier et al. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wakita teach that it is well known in the art to add additives such as palmitic acid

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and stearic acid to enhance the dispersion in solution and to further increase the solderability of the surface (col. 1, line 28 and col. 2, lines 13-26).

Applicant further asserts that the prior art of Wakita is from an entirely different art as compared to the current application and would not have been known to the skilled artisan. In response to applicant's argument that Wakita is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Wakita deals specifically with the solderability of a surface which comprises silver, exactly in line with Applicant's claimed invention. Furthermore, the classification of the references is not material in this instance because it is the teaching of the WHOLE reference, not the claims, that the Examiner is using against Applicant's invention. Applicant should be advised that classification is used merely as a tool for examiner's to find art which is organized by the claimed subject matter. Classification is in now way a showing of all that is disclosed in a patent.

Applicant also asserts that Wakita fails to disclose why the fatty acids are disclosed in the paint and as such the art has been improperly applied. Examiner must respectfully disagree. Wakita discloses on col. 2 between lines 13 and 26 that the "dispersants" such as palmitic acid and stearic acid are added in an effort better

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disperse the silver-plated copper in solution and to increase the solderability of the surface.

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Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley Nicolas whose telephone number is (703)305-0082. The examiner can normally be reached on Mon.-Thurs. from 7am to 5pm.

The Supervisory Primary Examiner for this Art Unit is Kathryn Gorgos whose telephone number is (703) 308-3328.

The fax number for this Group is (703)305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.


Kathryn Gorgos
Supervisory Patent Examiner
Technology Center 1700

Wesley Nicolas

August 14, 2000